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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ARTHUR REISMAN

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03/23/2007

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT

PAPER NUMBER

2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/435,736	Applicant(s) REISMAN, ARTHUR	
	Examiner Minh Dieu Nguyen	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 13, 14, 16-24 and 26-45 is/are pending in the application.
- 4a) Of the above claim(s) 1, 12, 15 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11, 13, 14, 16-24 and 26-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the pre-appeal brief filed on 11/17/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

2. Claims 2-11, 13-14, 16-24 and 26-45 are pending.

Response to Arguments

3. Applicant's arguments dated 11/17/2006 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims 2-4, 6, 13, 16-18, 20, 23, 26, 30 and 34 are objected to because of the following informalities: the phrase "wherein the first and datum are communication in a message" appears to miss an element. It should be "wherein the first and **second** datum are communication in a message". Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 28 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

Art Unit: 2137

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 4-5, 10-11, 18-19, 23-24, 26-30, 32-35 and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Saliba et al. (6,052,710).

a) As to claims 44-45 and 28, Saliba discloses a method of communicating data between a first computing device and a second computing device (i.e. an extensible, bi-directional function calling protocol tunnels function call requests and responses through the HTTP message stream of a standard Web browser and a standard Web server, see Saliba: Abstract), the method comprising the steps of: at a first computing device, receiving input information from one Web page displayed to a user (i.e. consumer uses a Web browser to request and download hypertext documents from merchant Web sites, see Saliba: col. 1, lines 27-29), the input information comprising at least first (e.g. credit card information) and second datum (e.g. shipping address information) corresponding respectively to at least first and second user input fields, wherein the first datum comprises at least one of a credit card number and a social security number (i.e. the hypertext documents contain various product offerings and other purchase-related information of the respective merchants, and typically include forms for allowing consumers to return payment and address information to the merchants, see Saliba: col. 1, lines 33-38); at the first computing device, a program determining which of the at least first and second user input fields contains confidential information, wherein the first datum is confidential to the user and the second datum is not confidential to the user (i.e. encrypting and forwarding to the merchants payment

Art Unit: 2137

(e.g. credit card information) and providing to merchants address information for the shipping of goods, see Saliba: col. 7, lines 5-8); the first computing device communicating the first datum to a second computing device over an untrusted network (e.g. the Internet, see Saliba: col. 4, lines 14-35) with encryption of the first datum (i.e. encrypting and forwarding to the merchants payment (e.g. credit card) information; and the first computing device communicating the second datum over the untrusted network to the second computing device without encryption of the second datum (i.e. providing to merchants address information for the shipping of goods).

b) As to claims 4-5 and 18-19, Saliba discloses the method of claim 44, wherein the first and second datum are communication in a message and wherein the step of communicating the first datum of the message with encryption of the first datum and the step of communicating the second datum of the message without encryption of the second datum comprise the step of employing a same path, TCP/IP passage, between the first computing device and the second computing device to communicate the first datum with encryption and the second datum without encryption (see Saliba: col. 4, lines 46-54).

c) As to claim 23, Saliba discloses the system of claim 45 wherein the first and datum are communication in a message wherein the second computing device employs the procedure to encrypt the first datum for communication of the first datum of the message from the second computing device to the first computing device (see Saliba: col. 7, lines 5-6).

d) As to claim 10, Saliba discloses the method of claim 44, wherein the web page comprises hypertext markup language (see Saliba: col. 1, lines 33-38), wherein the first datum comprises the credit card number, wherein the second datum comprises information related to a purchase by the user (i.e. shipping address information), wherein the program is embedded in the Web page (see Saliba: col. 4, lines 21-45) and further comprising loading the program on the first computing device after the Web page is received by the first computing device (see Saliba: Fig. 3).

e) As to claims 11 and 24, Saliba discloses the system of claim 45, wherein the procedure is based on a machine independent Web protocol (see Saliba: Fig. 1).

f) As to claims 26-27, Saliba discloses the first and datum are communication in a message and the step for the first computing device to communicate the encrypted and non-encrypted data to the second computing device with encryption of the first datum and without encryption of the second datum comprises the step of employing the procedure to select the first datum of the message for communication of the first datum from the first computing device to the second computing device with encryption of the first datum and the procedure to select the second datum of the message for communication of the second datum from the first computing device to the second computing device without encryption of the second datum (see Saliba: col. 7, lines 5-8).

g) As to claim 29, Saliba discloses the method of claim 44, wherein the first datum is confidential information to a user (i.e. credit card number, see Saliba: col. 7,

lines 5-6) and the second datum is non-confidential information to the user (i.e. shipping address information, see Saliba: col. 7, lines 7-8).

h) As to claims 30 and 34, Saliba discloses the method of claim 44, wherein the first and datum are communication in a message and the method further comprising: receiving the input information from a user, the input information comprising a plurality of input fields (see Saliba: col. 13, lines 32-40), ii) determining each input field comprising confidential information to the user and each input field comprising non-confidential information to the user, wherein the first datum (i.e. credit card number) is confidential information and the second datum (i.e. shipping address information) is non-confidential information (see Saliba: col. 7, lines 5-8).

i) As to claims 32 and 35, Saliba discloses the method of claim 30, wherein the communicating steps comprise: i) encrypting the information in each of the input fields identified as comprising confidential information (see Saliba: col. 7, lines 5-6), ii) not encrypting the information in each of the input fields identified as comprising non-confidential information (see Saliba: col. 7, lines 7-8).

j) As to claim 33, please see above addressed claim 10.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2137

10. Claims 2, 13-14, 16, 31 and 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saliba et al. (6,052,710) in view of Ice (6,598,031).

a) As to claims 36 and 39-40, Saliba discloses a method of communication data between a first computing device and a second computing device (i.e. an extensible, bi-directional function calling protocol tunnels function call requests and responses through the HTTP message stream of a standard Web browser and a standard Web server, see Saliba: Abstract), the method comprising (a) a browser on the first computing device providing a Web page to a user (i.e. consumer uses a Web browser to request and download hypertext documents from merchant Web sites, see Saliba: col. 1, lines 27-29), the Web page comprising at least first and second input fields for input from the user and at least a first presentation field associated with the at least first (i.e. credit card) and second (i.e. address information) input fields (i.e. the hypertext documents contain various product offerings and other purchase-related information of the respective merchants, and typically include forms for allowing consumers to return payment and address information to the merchants, see Saliba: col. 1, lines 33-38); (b) a program on the first computing device receiving a message from the user (i.e. a model of interaction in a distributed system in which a program at one site sends a request to a program at another site and waits for a response, see Saliba: col. 4, lines 36-45), wherein the message comprises at least a first and a second datum input by the user into the at least first and second input fields, respectively, of the Web page, wherein the first datum (i.e. credit card information) is confidential to the user and the second datum (i.e. shipping address information) is non-confidential to the

Art Unit: 2137

user (i.e. encrypting and forwarding to the merchants payment (e.g. credit card information) and providing to merchants address information for the shipping of goods, see Saliba: col. 7, lines 5-8); (c) the program identifying that the first datum is confidential and the second datum is non-confidential (i.e. only financial information such as credit card information is encrypted, and non-confidential information such as shipping address information is sent in clear, see Saliba: col. 7, lines 5-8); (d) the first computing device communicating to the second computing device over an untrusted network (e.g. the Internet, see Saliba: col. 4, lines 14-35), the first datum with encryption (i.e. credit card information) and (e) the first computing device communicating to the second computing device over the untrusted network, the second datum without encryption (i.e. shipping address information). Saliba is silent on the capability of having steps (d) and (e) occur at least substantially simultaneously.

Ice is relied on for the teaching of having steps (d) and (e) occur at least substantially simultaneously (i.e. the data transferred from the personal computer 14 to the payment server 34 includes both encrypted information identifying the credit card number and unencrypted information specifying ...the address to which the transaction is to be billed, see Ice: col. 4, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having steps (d) and (e) occur at least substantially simultaneously in the system of Saliba, as Ice teaches, so as to provide sufficient flexibility and extensibility to allow complex electronic commerce functionality to be

Art Unit: 2137

integrated into client and server software components (see Saliba: col. 1, line 64 to col. 2, line 2).

b) As to claims 2, 16, 37 and 42, the combination of Saliba and Ice discloses the method of claim 44, wherein the step of communicating the first datum of the message with encryption of the first datum and the step of communicating the second datum of the message without encryption of the second datum comprise the step of communicating the first datum with encryption and the second datum without encryption in a same packet that comprises the message (see Ice: col. 4, lines 25-30).

c) As to claims 13-14, the combination of Saliba and Ice discloses the first and datum are communication in a message and the step for the first computing device to communicate the encrypted and non-encrypted data to the second computing device with encryption of the first datum and without encryption of the second datum comprises the step of employing the procedure to select the first datum of the message for communication of the first datum from the first computing device to the second computing device with encryption of the first datum and the procedure to select the second datum of the message for communication of the second datum from the first computing device to the second computing device without encryption of the second datum (see Saliba: col. 7, lines 5-8).

d) As to claims 31 and 41, the combination of Saliba and Ice discloses the method wherein the communicating steps occur at least substantially simultaneously (see Ice: col. 4, lines 25-30).

e) As to claim 38, the combination of Saliba and Ice discloses the method of claim 44, wherein the web page comprises hypertext markup language (see Saliba: col. 1, lines 33-38), wherein the first datum comprises the credit card number, wherein the second datum comprises information related to a purchase by the user (i.e. shipping address information), wherein the program is embedded in the Web page (see Saliba: col. 4, lines 21-45) and further comprising loading the program on the first computing device after the Web page is received by the first computing device (see Saliba: Fig. 3).

f) As to claim 43, please see above addressed claim 38.

11. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saliba et al. (6,052,710) in view of Trcka et al. (2001/0039579).

Saliba discloses the method of claim 44, however Saliba is silent on the capability of communicating the first datum with encryption in a first packet of the message; and communicating the second datum without encryption in a second packet of the message different from the first packet of the message. Trcka is relied on for the teaching of communicating the first datum with encryption in a first packet of the message; and communicating the second datum without encryption in a second packet of the message different from the first packet of the message (see Trcka: Fig. 6a, i.e. encrypted data packets are transmitted separately from unencrypted data packets).

It would be obvious to one of ordinary skill in the art at the time of the invention to employ the use of communicating the unencrypted data in a second packet of the

message different from the first packet of encrypted data of the message in the system of Saliba, as Trcka teaches so as to easily track data packets.

12. Claims 6, 8-9 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saliba et al. (6,052,710) and in view of Schneier (Applied cryptography).

Saliba is silent on the capability of employing a second key to decrypt the first datum of the message and the first and second key comprised a matched key to communicate the encrypted data.

Schneier is relied on for the teaching of employing a second key to decrypt the first datum of the message and the first and second key comprised a matched key to communicate the encrypted data (i.e. discloses communications using symmetric cryptography wherein the second key is used to decrypt the encrypted message (page 28, item (5)) and the first (page 28, item (3)) and second key comprised a matched key (page 28, item (5)) to communicate the encrypted data).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of a second key to decrypt the first datum of the message and the first and second key comprised a matched key to communicate the encrypted data in the system of Saliba, as Schneier teaches so as to protect the sensitive data.

13. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saliba et al. (6,052,710) and in view of Chang et al. (6,105,012).

Saliba discloses the method of claim 44, however he is silent on the capability of having the step of communicating a key from the second computing device to the first computing device, and wherein the step of communicating the first datum of the message from the first computing device to the second computing device with encryption of the first datum comprises the step of employing the key to encrypt the first datum of the message for communication of the first datum from the first computing device to the second computing device. Chang is relied on for the teaching of having the step of communicating a key from the second computing device to the first computing device, and wherein the step of communicating the first datum of the message from the first computing device to the second computing device with encryption of the first datum comprises the step of employing the key to encrypt the first datum of the message for communication of the first datum from the first computing device to the second computing device (see Chang: col. 7, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having the step of communicating a key from the second computing device to the first computing device, and wherein the step of communicating the first datum of the message from the first computing device to the second computing device with encryption of the first datum comprises the step of employing the key to encrypt the first datum of the message for communication of the first datum from the first computing device to the second computing device in the system of Saliba, as Chang discloses, so as to securely transmitting transactions in an electronic communication systems (see Chang: col. 1, lines 5-7).


Conclusion

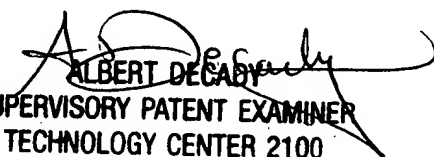
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dieu Nguyen
Examiner
Art Unit 2137


mdn
3/19/07


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